

PATENT APPLN. NO. 10/573,755
RESPONSE UNDER 37 C.F.R. § 1.116

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REMARKS

Claims 4, 11 and 12 have been amended to provide for consistency of claim language. The amendments do not raise new issues or require further search and/or consideration and should be entered.

Initially, applicants request withdrawal of the finality of the present Action. The making of the Action Final is not proper according to the provisions of MPEP § 706.07(a). MPEP § 706.07(a) provides:

"Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

In the first Office Action dated September 10, 2009, the claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over Inuzuka et al., U.S. Patent Application Publication No. 2001/0000042 ("Inuzuka") in view of Hustad, U.S. Patent No. 5064664 ("Hustad '664"), and in view of Hustad '664 and Brochman, U.S. Patent No. 3923198. Hustad '664 did not support the rejection

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because the column and line numbers and drawing figures cited in the Action are not consistent with the disclosure and drawings of Hustad '664. For example, the Office referred to Figs. 5 and 6 and Figs. 10 and 11 of Hustad '664. However, Hustad '664 includes only Figs. 1 and 2.

The Office is now citing Hustad, U.S. Patent No. 5103979 ("Hustad '979"), for the same teachings for which Hustad '664 was cited in the first Action. The citing of Hustad '664 is not necessitated by amendments to the claims and, when combined with the other prior art cited in the Final Action, effectively constitutes a new ground of rejection that should not have been made final.

In the Final Office Action the Office states that the error in the identification of the Hustad reference in the first Action did not "disadvantage the Applicant with respect to the prosecution history." (Final Office Action, page 8, lines 1-2). Disadvantage to the Applicant is not the issue. The Office cited the wrong reference in the first Action. Moreover, the Applicant was in fact disadvantaged in terms of time required to resolve the error.

Referring to the Final Action, the Office has removed the 35 U.S.C. § 101, 35 U.S.C. § 112, and 35 U.S.C. § 103(a) rejections that were made in the first Action. The Office is now rejecting

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the claims remaining in the application, claims 1-4, 7 and 10-12, under 35 U.S.C. § 103(a) as being unpatentable over Sperko et al., US 5910138 ("Sperko"), in view of Hustad et al., US 5103979 ("Hustad"), and Brochman, US 3923198.

In the response filed February 10, 2009, to the first Action, Applicant argued that Inuzuka did not disclose a separation display section. Applicant argued that although Hustad discloses a separation display section, the separation display section is printed on an inner surface of the partition wall section. Applicant further argued that although Brochman discloses an indicator strip 16 that is provided on an outer surface of a container, Brochman does not disclose a "separation display section provided by printing directly on outer surface of said partition wall section of at least one of the container outer members", the separation display section "being visible from outside the container outer member opposed to the container outer member on which the separation display section is provided, prior to separation of the partition wall section" as required by the claims of the present application. Finally, Applicant argued that the combination of Inuzuka and Hustad '979, and the combination of Inuzuka and Hustad '979 and Brochman do not disclose or suggest a separation display section that is at least partially blocked by

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contents in the medical container when the partition wall section is separated as required by the present claims.

In the present Action, the Office is citing Sperko as disclosing a separable partition wall section that is at least partially blocked by contents in the medical container when the partition wall section is separated.

Hustad is cited as disclosing a hermetically sealed package which includes a separation display section.

The Office notes that the combination of Sperko and Hustad discloses only a separation display section printed directly on a separation display means and lacks printing on an outer surface.

Brochman is cited as disclosing a tape closure system having an opacifying layer and obscuring effect and further comprising a separation display means provided on an outer surface of a container. The term "printing" in the claims of the present application is being interpreted broadly as including the indicator strip of Brochman.

The Office concludes that it would have been obvious to modify the invention of Sperko in view of Hustad to include the display section of Hustad and to use the separation display means taught by Brochman.

Applicant respectfully submits that a person of ordinary skill

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in the art would not have been motivated to provide the medical container of Sperko with a display section as taught by Hustad at the separable partition wall section. Moreover, the proposed modification of Sperko according to the combined teachings of Hustad and Brochman would not have resulted in the medical container of the present invention as defined in the rejected claims.

First, the Office notes on page 4 of the Action that:

"One would be motivated to modify Sperko with the separation display section as taught by Hustad to ensure that mixing has occurred since Sperko calls for a transparent material that allows a user to inspect contents visually (col. 8, lines 19-31, especially lines 28-31. in [sic] other words, Sperko points out the importance of inspecting the contents of a mixing bag before dispensing to a patient." (Emphasis Applicant's).

However, Sperko discloses in col. 8, lines 27-31, that:

"This is a particularly dangerous situation when administering medication intravenously. It is imperative that a nurse or clinical worker be able to tell, at a glance, that any such medication being administered from a medical container is free from particulate matter." (Emphasis Applicant's).

A person of ordinary skill in the art would not have been motivated to provide the separable partition wall section of the

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medical container of Sperko with a display section as proposed by the Office because a display section is not required to determine whether medication being administered from a medical container is free from particulate matter. Sperko satisfies the requirement of determining whether medication being administered from a medical container is free from particulate matter by the use of a transparent front sheet. Moreover, a display section, in fact, could obscure particulate matter in the medication and make it difficult to obtain the effect of the invention of Sperko.

Second, providing an indicator strip as taught by Brochman on an outer surface of the separable partition wall of at least one of the container outer members of Sperko would not provide a separation display section that is visible from outside the container outer member opposed to the container outer member on which the strip is provided, prior to separation of the partition wall section, and be at least partially blocked by contents in the medical container when the partition wall section is separated as required by the claims of the present application. The indicator strip of Brochman provided on the outer surface of the separable partition wall of at least one of the container outer members would not opacify when the partition wall section is separated because the partition wall section is stressed - not the specified

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indicator strip. Therefore, a user would not be able to recognize that the plural chambers are communicating with each other.


Removal of the 35 U.S.C. § 103(a) ground of rejection is in order and is respectfully requested.

The foregoing is believed to be a complete and proper response to the Office Action dated April 22, 2009, and is believed to place this application in condition for allowance.

In the event that this paper is not considered to be timely filed, Applicant hereby petitions for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,
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